

REMARKS

Claims 39-49 are pending in the application. By this Amendment, claims 39, 40, and 48 have been amended to more clearly define features of the present invention. No new matter has been entered.

As an initial matter, Applicants wish to express sincere appreciation to the Examiner for the courtesy extended to Applicants' representatives during the personal interview held on April 19, 2004. At the interview, all of the rejections outstanding in the February 4, 2004 Office Action were discussed. The following remarks reflect the subject matter discussed during the interview.

Double Patenting Rejection

In the final Office Action, claims 39-49 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,653,581 ("581 patent"). Despite Applicants' remarks filed on November 13, 2003, addressing the impropriety of this rejection, the Examiner maintained the rejection, stating that "[t]he Office maintains the patent *teach* in claim 11 ..." (Emphasis added). Applicants do not agree with the Examiner's reasoning for the reasons set forth on pages 1-3 of the November 13, 2003 reply. Moreover, the Examiner's rejection is improper because a proper double patenting analysis examines the differences in the scope and content between a patent claim and an application claim. In other words, the focus of the double-patenting analysis is on what a patent claim "defines," not what the patent claim "teaches", because the disclosure of the patent should not be used as prior art. MPEP § 804.

Nevertheless, without prejudice to any future applications or subject matter and in order to expedite the prosecution of this case and to place this case in condition for immediate allowance, Applicants submit herewith a Terminal Disclaimer under 37 C.F.R. § 1.321 to obviate this rejection. Thus, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejection Under 35 U.S.C. § 102(e)

In the final Office Action, claims 39-40 and 44-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Woudenberg et al. (U.S. Patent Nos. 6,015,674 and 5,928,907). For the following reasons, Applicants respectfully request reconsideration and withdrawal of this rejection.

Independent claim 39 recites an apparatus comprising, among other things, “a lens assembly ... including a plurality of plates, one of said plates comprising a lens plate in which a plurality of lenses are located for focusing a light which passes through the lenses.” Independent claim 48 recites a method comprising, among other things, “placing a lens plate having a plurality of lenses over the substrate and support frame.”

A claim is anticipated under 35 U.S.C. § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. As detailed below, Woudenberg et al. does not anticipate the claimed invention because it fails to disclose each and every element of independent claims 39 and 48.

Woudenberg et al. discloses a system for measuring in real time polynucleotide products from nucleic acid amplification processes. In the rejection statement, the

Examiner asserted that multiple lenses 8, 38, and 44 of Woudenberg et al. correspond to the recited “lens assembly” and, in particular, “plurality of plates” of the lens assembly.

Without accepting the Examiner’s assertion, Applicants respectfully submit that such expansive interpretation of Woudenberg et al.’s teachings should no longer be applicable because each of independent claims 39 and 48 recites a lens plate having a plurality of lenses. As is apparent, Woudenberg et al. does not disclose the recited “lens plate” having a plurality of lenses.

In addition to the reason stated above, claim 39 is also allowable because Woudenberg et al. also does not disclose, among other things, a “frame assembly ... configured so that a substrate may be positioned in the frame assembly,” as recited in claim 39. Applicants hereby incorporate by reference its arguments from the November 13, 2003 reply with respect to the recited “frame assembly” limitation.

Moreover, claim 48 is also allowable because Woudenberg et al. also does not disclose, among other things, “placing a support frame on the sample detection instrument,” and “inserting a substrate with at least one sample detection chamber in the support frame.” Applicants hereby incorporate by reference its arguments from the November 13, 2003 reply with respect to these limitations.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(e).

Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woudenberg et al.

Dependent claims 41-43 depend from independent claim 39, and thus include all elements and limitations thereof. As discussed above, independent claim 39 is patentably distinguishable over Woudenberg et al. Therefore, at least by virtue of their dependency from allowable claim 39, dependent claims 41-43 should also be allowable. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

The final Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicants decline to subscribe to any statement or characterization in the final Office Action, regardless of whether it is addressed above.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered, placing all pending claims 39-49 in condition for allowance. Applicants also submit that the proposed amendments of claims 39, 40, and 48 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships were previously claimed.

It is respectfully submitted that all pending claims 39-49 are in condition for allowance. Therefore, timely issuance of a Notice of Allowability is respectfully requested. If the Examiner would like to discuss this case, he is invited to contact the undersigned at 202-408-4391.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 3, 2004

By: Troy E. Grabow
Troy E. Grabow
Reg. No. 43,440